

REMARKS

Applicants submit this Amendment in reply to the final Office Action mailed May 4, 2006 and Advisory Action mailed November 7, 2006. By this Amendment, Applicants amend claims 1 and 2. Claims 1-24 are pending in this application. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of amended claims 1 and 2. No new matter is introduced.

On pages 3-4 of the final Office Action, claims 1-3, 12, 14, 15, and 17-24 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,142,980 to Schalk ("Schalk"). Applicants respectfully traverse this rejection.

Schalk does not disclose or suggest the invention as claimed in independent claim 1. For example, independent claim 1 recites a suction adapter having "a manifold having at least three ports, the ports including a suction port connected to a suction source, a first device port accommodating the first medical device that receives suction and inserts into a body lumen for performing a first procedure, and a second device port accommodating the second medical device that receives suction and inserts into the body lumen for performing a second procedure." Schalk does not disclose or suggest at least these aspects of the claimed invention either alone or in combination with the other aspects of the claimed invention.

Page 2 of the Advisory Action asserts the following:

The Examiner notes that the terms "suction port," "first device port" and "second device port" impart no specific structural limitations to the claimed manifold. The terminology merely defines the intended use of the ports, absent any claim limitations positively reciting that the "suction port" is attached to a source of suction, that the "first device port" is attached to a first medical device and that the "second device port" is attached to a second medical device. A recitation of the intended use of the claimed

invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In order to meet the limitations of the claim, a prior art reference must only teach a manifold having three ports which are merely capable of performing the claimed intended use.

While Applicants do not necessarily agree with the aforementioned assertions set forth in the Advisory Action, Applicants have amended claim 1 to specifically recite "a suction port connected to a suction device, a first device port accommodating the first medical device..., and a second device port accommodating the second medical device." Accordingly, any cited reference must now not be "merely capable of performing the claimed intended use," but must actually perform the intended use.

In that regard, Schalk discloses a control valve assembly 10 that includes an inlet section 20 with inlet passage 36, an outlet section 24 with outlet passage 48, a poppet valve 74, and a vacuum relief valve 76. Duckbill valve 50 is disposed between inlet section 20 and outlet section 24. During operation, "[d]uckbill valve 50 is operable to permit fluid flow from inlet passage 36 to outlet passage 48 while preventing fluid flow in the opposite direction from outlet passage 48 to inlet passage 36." (Col. 3, lines 9-13). Poppet valve 74, in its open position, establishes a flow pathway to vent pressure from outlet passage 48 to ambient. Vacuum relief valve 76 "limit[s] the vacuum level within outlet passage 48 to a preselected maximum negative pressure valve by permitting ambient air to be introduced through a vacuum portion 78 into outlet passage 48." (Col. 3, line 65 through col. 4, line 12).

In the final Office Action and Advisory Action, the Examiner appears to assert that an opening adjacent inlet passage 36 corresponds to the claimed "first device port,"

and an opening adjacent reference character 64 corresponds to the claimed "second device port." Schalk, however, does not disclose at least that an opening adjacent reference character 64 accommodates "a medical device that receives suction and inserts into the body lumen for performing a [] procedure." Instead, the opening adjacent character 64 accommodates relief valve 76, an important component to the operation of control valve assembly 10. To remove vacuum relief valve 76 would impermissibly destroy the device of Schalk by rendering it unsatisfactory for its intended purpose. See In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For at least these reasons, Applicants respectfully request withdrawal of the Section 102(e) rejection based on Schalk.

On pages 4-6 of the final Office Action, claims 1-3, 12-15, 17-20, 23, and 24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,346,477 to Edwards et al. ("Edwards"), and claims 4-11 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Edwards. Applicants respectfully traverse these rejections for similar reasons as set forth above with respect to Schalk.

Edwards discloses a pressure infusion apparatus 10 including a dump valve 40.

[D]ump valve 40 generally comprises a valve body 80 having an inlet 82 coupled to a length of flexible tubing 34 and an outlet 84 coupled to another length of flexible tubing 34. The inlet 82 also comprises a "duckbill" type check valve 86, although other forms of check valves are as suitable without departing from the scope of this invention. An extension 88 of the valve body 80 also includes a luer valve 90, which is adapted to release built-up pressures within the pressure infusion apparatus in a well known manner.

(Col. 7, lines 22-32). Specifically, dump valve 40, connected to pressure cuff 14 via flexible tubing 34, is "used to release pressure from the bladder means of the pressure cuff 14 as necessary." (Col. 4, lines 60-63).

On page 4 of the final Office Action, the Examiner appears to assert that an opening adjacent inlet 82 corresponds to the claimed "first device port," and the opening adjacent extension 88 leading to luer valve 90 corresponds to the claimed "second device port." Edwards, however, does not disclose at least that the opening adjacent extension 88 accommodates "a medical device that receives suction and inserts into the body lumen for performing a [] procedure." Instead, the opening adjacent extension 88 accommodates luer valve 90, an important component to the operation of dump valve 40. To remove luer valve 90 would impermissibly destroy the device of Edwards by rendering it unsatisfactory for its intended purpose. See In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For at least these reasons, Applicants respectfully request withdrawal of the Section 102(b) rejection based on Edwards.

As the Section 103(a) rejection does not address the aforementioned deficiencies of Edwards, Applicants respectfully request withdrawal of the Section 103(a) rejections based on Edwards.

Applicants further submit that claims 2-24 depend from independent claim 1, and are therefore allowable for at least the same reasons that independent claim 1 is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by the cited references, and therefore at least some also are separately patentable.

Applicants respectfully assert that this Amendment places claims 1-24 in condition for allowance. This claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The final Office Action and Advisory Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the final Office Action or Advisor Action.


In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time, not otherwise provided for, that are required to enter this Amendment, and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 5, 2007

By: 
Michael W. Kim
Reg. No. 51,880